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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/768,727	01/29/2004	Keven E. Miller	TN-1697A	7925

7590

01/07/2005

Black & Decker Inc.
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EXAMINER

NASH, BRIAN D

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 01/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/768,727

Applicant(s)

MILLER ET AL.

Examiner

Brian Nash

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>11/15/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The present application is a continuation to parent application 10/054,137 now US 6,705,501. The pending claims are 1-9.
2. The examiner acknowledges applicant's amendment to the specifications received 29 January 2004; however, a further amendment will be required should the present application be issued since parent application 10/054,137 is now US 6,705,501.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6,705,501 to Miller et al. Although the conflicting claims are not identical, they are not patentably distinct from each other. Claim 1 of the present invention (application 10/768,727) has merely removed certain limitations that broaden the claim but do not change the scope so as to be patentably distinct from claim 1 of issued parent (US 6,705,501). Specifically, the present claims are more broad in

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that they lack the directional movement of the contact trip relative to movement of the adjuster as well as the unbiasing of the adjuster towards the first position. It is within the scope of the skilled artisan to remove elements non-critical to the successful operation of the tool, notably the transverse movement of the trip relative to the adjuster. Further, it would have been obvious to one having ordinary skill in the art to allow for biasing of the adjuster toward the first position if desired in order to allow for a more effective mating between the elements. In addition, to provide a "link", or any elements for that matter, between the adjuster and knob is an obvious design expedient since such an element is an inherent connection between the two to allow for successful operation.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,219,110 to Mukoyama in view of US 6,209,770 B1 to Perra. Mukoyama discloses the invention substantially as claimed including a fastening tool having a housing, a magazine connected thereto, and a driving mechanism (see Figs. 1-3); Mukoyama also shows a trigger assembly (6) pivotally attached to the housing having a main trigger (6a) and a supplemental trigger (6d) pivotally attached to the main trigger and a contact trip assembly (8) having an upper portion (10) contacting the supplemental trigger and a lower portion (9). However, Mukoyama does not

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show an adjuster having teeth that can mesh with teeth on one of the upper or lower contact trips, the adjuster being movable between a first position where the teeth of the adjuster mesh with the other of the upper contact or lower contact trips, and a second position where the teeth of each do not mesh, wherein the adjuster moves between the first and second positions along a direction substantially perpendicular to the first substantially vertical direction, and a detent mechanism associated with the adjuster for maintaining the adjuster in at least one of the first and second positions.

However, Perra teaches an adjuster assembly (66) supported by an upper portion of the contact trip and having teeth that mesh with a lower portion of the contact trip. The adjuster moves substantially in a perpendicular direction to the first substantially vertical direction as it moves from a first meshing position to a second non-meshing position (see column 7, lines 25-48). The adjuster assembly moves via a manually operable detent mechanism (68), i.e. a knob, that comprises a biasing mechanism (100) that moves a locking element (74) in a direction toward a notch (96) in the housing for the purpose of preventing relative movement between moveable parts of the fastener tool.

It would have been obvious to one having ordinary skill in the art at the time of the invention to have incorporated the adjuster assembly of Perra having a locking and spring-biased detent mechanism for the purpose of providing a fastener tool with a trip assembly that can be easily adjusted manually.

Regarding claims 8 and 9, it would have been an obvious matter of design choice for the manually operable detent mechanism (68), i.e. the knob, to be rotatably attached to the housing via a link that is slidably received in a channel as shown by Mukoyama wherein a knob (14b) is

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attached to the housing and a link (14) is connected to the adjuster (11) at one end and to the knob at the other and wherein the knob has a channel (4,16 – see Fig. 2 of Mukoyama) for slidably receiving the link. Furthermore, the specs support that “persons skilled in the art shall recognize” that button 103, i.e. a knob, may be disposed in any place, i.e. in different locations that would require different attachment means, so long as it can move the adjuster.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Fa et al, Adachi, Monacelli, Kerrigan, and Doyle are cited to show related references.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Nash whose telephone number is 571-272-4465. The examiner can normally be reached on Monday – Thursday from 8 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached at 571-272-4467.

The official fax number for this Group is: 703-872-9306

Brian Nash
5 January 2005



**SCOTT A. SMITH
PRIMARY EXAMINER**